PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number	
20423-05957	

Application Number	Filed
10/046,496	**10/29/2001**

On_____

Signature_____

Typed or printed
name **Brian M. Hoffman**_____

First Named Inventor	
Carey Nachenberg	

Art Unit	Examiner
2137	**Jeffery L. Williams**

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
    Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.

☒ attorney or agent of record.
Registration number **39,713**.

☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

_____/Brian Hoffman/_____
                    Signature

____Brian M. Hoffman, Reg. No. 39,713_____
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                  Telephone number

_____October 10, 2008_____
                        Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below".

☒ *Total of _____1_____ forms are submitted.

ATTACHMENT TO THE PRE-APPEAL BRIEF REQUEST FOR REVIEW

Pre-appeal review is requested because the rejections of record are improper for at least the reasons set forth below.

Status Of The Claims

Claims 1-17, 20, and 22-34 are pending and stand rejected. Claims 1-10, 12-17, 20, and 22-34 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Bates et al., U.S. Patent 6,721,721, in view of Hericourt et al., U.S. Patent 7,099,916. Claim 11 stands rejected as being unpatentable over the combination of Bates and Hericourt in view of Symantec, "Norton AntiVirus Corporate Edition." The Panel is requested to withdraw the § 103(a) rejections in view of the remarks below.

The Rejection Of The Claims Is Predicated On An Unreasonable Interpretation

The claimed invention uses a virus outbreak report indicating a virus attack to compute a computer virus alert time. The computer virus alert time is compared with a time stamp corresponding to an earliest moment or first time computer code was allowed to execute on a computer coupled to a computer network, and the executability of the computer code is determined in response to the comparison. Specifically, most of the independent claims recite limitations corresponding to:

> entering a first computer virus status mode in response to a first computer virus outbreak report indicating a virus attack threat to a computer network;
> computing a first computer virus alert time corresponding to entry into the first computer virus status mode;
> *comparing a time stamp of executable computer code corresponding to an earliest moment the computer code was allowed to execute on a computer coupled to the computer network with the first computer virus alert time; and*
> determining the executability of the computer code in response to the result of the comparing step.

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(quoting from claim 1). Dependent claim 8 further recites that the "computer code is determined to be executable only when the computer code is time stamped prior to the first computer virus alert time." In other words, the computer code is executable because it executed before the virus alert and, therefore, is unlikely to be infected by the virus implicated in the alert. Independent claim 34 resembles claim 1, except that the time stamp of the executable computer code corresponds "to a *first time* the computer code was allowed to execute on a computer coupled to the computer network."

The cited references, at the least, fail to disclose a time stamp "corresponding to an *earliest moment* the computer code was allowed to execute on a computer…" or "corresponding to a *first time* the computer code was allowed to execute on a computer…" Bates discloses a system that integrates virus checking functionality into a computer database search environment, thereby allegedly decreasing the risks of viruses associated with accessing search results from computer database searches. *See* Bates, Abstract; column 3, lines 1-3. At col. 9, line 56 – col. 10, line 8, Bates describes how the user can assess the "trustworthiness" of a search result file by setting a virus criterion as to (i) whether the file has been virus checked within a predetermined period of time; (ii) whether the file has been changed since the last time a virus check was performed; or (iii) whether a particular period of time has elapsed in which the file has been found to be free of viral infection. Thus Bates at most discloses use of a single time stamp indicating the time the file was *last checked* for a virus. There is no teaching or suggestion in Bates of a time stamp that indicates the earliest moment or first time computer code was allowed to execute.

In fact, Bates does not even teach or suggest recording computer code execution times. The Examiner acknowledges this deficiency of Bates, and seeks to cure it by citing to Hericourt.

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This latter reference provides an overview of antivirus software, and describes how a suspect file can be executed in a protected location to see if it exhibits any virus-like behavior. Hericourt, col. 3, lines 52-54. Hericourt does not teach or suggest using time stamps for any purpose. However, the Examiner alleges that Hericourt teaches that scanning a file can comprise an execution of the file. Therefore, according to the Examiner, when Bates and Hericourt are combined Bates' time stamp indicating when a file was found free of a viral infection becomes a time stamp indicating when the file was executed.

The combination of Bates and Hericourt does not render the claimed invention obvious because neither reference discloses or suggests using a time stamp that corresponds to an earliest moment, or first time, the computer code was allowed to execute on a computer coupled to a computer network. If the references are combined in the manner suggested by the Examiner, the time stamp at most represents a code execution occurring at an arbitrary time. The combination does not teach or suggest time stamping the earliest or first time code was executed; there might have been prior executions occurring before the time-stamped execution. Moreover, even if a particular time stamp in Bates did represent the earliest code execution, this happenstance event would not support the rejection. *See In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999) (stating that the mere fact that a certain thing may result from a given set of circumstances is not sufficient to support a rejection based on inherency); MPEP 2112 IV. Thus, a person of ordinary skill in the art at the time the invention was made, considering the teachings of the references either alone or in combination, would not find the claimed invention obvious.

The Examiner's defense of this rejection is essentially predicated on an unreasonable interpretation of the claims. Claims must be given their broadest reasonable interpretation consistent with the specification. *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005); MPEP

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§ 2111. Here, the Examiner's interpretation is unreasonable because it calls code executions "earliest" or "first" even if prior code executions have occurred.

The unreasonableness of the Examiner's interpretation is demonstrated through Applicants' and the Examiner's exchanges concerning this rejection. In a previous Office Action, the Examiner supported the rejection by stating that code can be executed multiple times, and that:

> ...out of the multitude of instances a particular piece of computer code is executed, either via scanning or via end-user execution, the timestamp associated with the virus check for that computer code represents "an earliest execution time" in comparison to subsequent instances of execution for that piece of computer code.

(Office Action of January 11, 2008, page 18 lines 2-6). In response, Applicants argued that:

> a particular timestamp in Bates cannot be said to represent the "earliest" execution because there are an arbitrary number of executions that occur before and after the execution represented by the timestamp.

(Amendment of April 10, 2008, page 14 lines 18-21). Thus, Applicants argued that there can be any number of executions *before and after* a given execution, and no time stamp in Bates necessarily represents the earliest or first execution.

The Examiner now asserts that Applicants have "admitted" that the time stamped "'execution time' is subsequently followed by a plurality of executions of the software." (Office Action of July 10, 2008, page 4 lines 12-14). And, therefore, Applicants:

> reasonably must also acknowledge that within such a sequence the time-stamped execution represents "**an** earliest" time of execution in comparison to the subsequent executions within that sequence

(Office Action of July 10, 2008, page 17, lines 10-13, emphasis in original).

In other words, the Examiner calls any given time-stamped execution the "earliest" or "first" one by arbitrarily excluding from consideration any executions that came before it. For

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example, if there were three sequential executions, the Examiner would call execution two "an earliest" execution because it occurred before execution three, even though execution one occurred earlier. Moreover, if there were a sequence of 10 time stamps, the Examiner would call nine of the time stamps "first." This interpretation is improper because it is clearly unreasonable.

The Symantec reference fails to remedy the deficiencies of Bates and Hericourt described above. Therefore, a person of ordinary skill in the art, considering the teachings of the references either alone or in combination would not find the claimed invention obvious.

Based on the foregoing, Applicants respectfully submit that the § 103 rejections suffer from clear deficiencies. Accordingly, Applicants requests that the rejections be withdrawn.

Respectfully submitted

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Date: <u>October 10, 2008</u>   By <u>   /Brian Hoffman/   </u>
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